

**REMARKS****I. Drawings**

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5), arguing that the drawings do not include the following reference sign(s) mentioned in the description: spring (194), referring to the specification, and paragraphs [0025] and [0026]. The Examiner indicated that corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. The Examiner indicated that any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The Examiner also indicated that each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). The Examiner also indicated that if the changes are not accepted, the Applicant will be notified and informed of any required corrective action in the next Office Action. The Examiner indicated that the objection to the drawings will not be held in abeyance.

The Applicant has amended the specification to properly refer to spring 104 instead of spring 194. The use of reference numeral 194 was simply an inadvertent minor error. It is believed that the cancellation of reference numeral 194 and the use of reference numeral 104 to refer to the spring is proper, as spring 104 is clearly shown in Applicant's Figures. It is believed that the objection to the drawings has now been overcome and that additionally there is not a need to submit replacement sheets. The Applicant respectfully requests withdrawal of the aforementioned objection to the drawings.

## II. Specification

The Examiner object to the disclosure because of the following Informalities: on page 13, line 30, change "next 608" to "nest 608". The Examiner indicated that appropriate correction is required. The Applicant has therefore amended paragraph [0039] as indicated herein so that "next 608" is now referred to as "nest 608".

## III. Claim Rejections – 35 U.S.C. § 102

### Requirements for Prima Facie Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show

that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the Initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

***Vongfuangfoo et al.***

Claims 1-7, 10, 11, and 14-17 were rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Vongfuangfoo et al, hereinafter "Vongfuangfoo" (U.S. Patent No. 5,598,775).

The Examiner argued that Vongfuangfoo discloses a welding method and fixture (citing reference numeral 10) comprising: a stationary pivot block (citing reference numeral 42) attached to a base (citing reference numeral 40), wherein the stationary pivot block is located adjacent to a nest (citing reference numerals 46, 47) for maintaining an object (citing reference numeral 12) to be welded, wherein the nest is located above and upon the base; a pivot arm (citing reference numeral 50) associated with a pivot arm insert (citing reference numeral 52), wherein the pivot arm rotates about a pivot point (citing reference numeral 44) provided by a pin press component associated with the stationary pivot block, such that the pivot point is fixed to the stationary pivot block in relation to the object to be welded and wherein the pivot arm is positioned parallel to the next; and a spring block (citing reference numeral 56) connected to the stationary pivot block, wherein the spring block provides tension to the pivot arm in order to permit a user to maintain the object upon the base with a desire tension for welding thereof; a torsion spring (citing reference numeral 78) and an adjustable position spring block (citing reference numeral 16) with a screw (citing reference numeral 80) and adjustable slots (citing reference numerals 84-86) to regulate the spring tension citing FIGS. 1-13, Column 2, line 41 to Column 4, line 64 of Vongfuangfoo).

The Applicant respectfully disagrees with this assessment. Claim 1 is directed toward all of the following claim limitations: a pre-load weld fixture apparatus, comprising: a stationary pivot block attached to a base, wherein the stationary pivot block is located adjacent to a nest for maintaining an object to be welded, wherein the nest is located above and upon the base; a pin press component associated with the stationary pivot block; a pivot arm associated with a pivot arm insert, wherein the pivot arm rotates about a pivot point provided by the pin press component associated with the stationary pivot block, such that the pivot point is fixed to the stationary pivot block in relation to the object to be welded and wherein the pivot arm is positioned parallel to the nest, wherein the nest, the pivot arm, and the pivot arm insert are formed from a material that dissipates heat and prevents an accidental welding of the object to the nest or the pivot arm; and a spring block connected to the stationary pivot block, wherein the spring block provides tension to the pivot arm in order to permit a user to maintain the object upon the base with a desired tension for welding thereof.

The Applicant reminds the Examiner that in order to succeed in a rejection to a claim under 35 U.S.C. 102(b), the reference utilized as a basis for the rejection must disclose each and every claim limitation of the rejected claim (i.e., see prima facie anticipation test described above). If even one claim limitation is lacking in the cited reference, the rejection under 35 U.S.C. 102(b) fails.

In this case, the Vongfuangfoo does not show all of the claim limitations of Applicant's claim 1. For example, Vongfuangfoo does not disclose a pin press component associated with the stationary pivot block. Where is such a pin press component present in Vongfuangfoo? The Examiner has not cited any section of Vongfuangfoo that actually shows a pin press component as taught by Applicant's invention. Additionally, Vongfuangfoo does not teach, show or disclose wherein the nest, the pivot arm, and the pivot arm insert are formed from a material that

dissipates heat and prevents an accidental welding of the object to the nest or the pivot arm. Where are such claim limitations taught by Vongfuangfoo?

Reference numeral 42 of Vongfuangfoo does not refer to a stationary pivot block but instead refers to a pair of axle pedestals 42 (see Vongfuangfoo, Column 3, lines 6-8). How does a pair of axle pedestals 42 constitute a stationary pivot block as taught by Applicant's invention? The Examiner has not explained how and why a pair of axle pedestals 42 constitutes the same component as the stationary pivot block taught by Applicant's invention. Additionally, reference numerals 46, 47 cited by the Examiner do not refer to a nest as taught by Applicant's invention, but instead refers to pair of index pins 46 and 47 (see column 3, lines 8-9 of Vongfuangfoo). Also, reference numeral 50 of Vongfuangfoo does not teach a pivot arm as taught by Applicant's invention, but instead refers to a clamping bar 50. The Examiner has not explained how and why the clamping bar 50 of Vongfuangfoo constitutes a pivot arm as taught by Applicant's invention.

Based on the foregoing, the Applicant submits that the rejection to claim 1 under 35 U.S.C. 102(b) fails under the aforementioned prima facie obviousness test. The Applicant also submits that the arguments presented above against the rejection to claim 1 apply equally against the rejection to claims 2-7, 10, 11, and 14-17. The Applicant therefore submits that the rejection to 2-7, 10, 11, and 14-17 has been traversed. The Applicant respectfully requests withdrawal of the rejection to claims 2-7, 10, 11, and 14-17.

Regarding claim 10, the Examiner asserted claims 1 and 10 are similar except that the object to be welded in claim 10 is a sensor. The Examiner asserted that the features disclosed in the welding fixture of Vongfuangfoo are inherently suitable or holding a sensor, therefore meeting the limitations as recited in claim 10. The Applicant respectfully disagrees with this assessment and notes that the rejection to claim 10 fails under the aforementioned prima facie obviousness test. That is, Vongfuangfoo does not disclose all of the claim limitations of Applicant's

claim 10, such as, for example, wherein said nest, said pivot arm, and said pivot arm insert are formed from a copper material in order to dissipate heat and prevent accidental welding of said sensor enclosure to said nest or said pivot arm.

Regarding claims 5-7 and 11, the Examiner argued that such claims are drawn to a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The Examiner asserted that if the prior art structure is capable of performing the intended use, then it meets the claim. Regarding the [object to be welded (SAW), sensor], the Examiner argued that these limitations are directed to a manner of operating the apparatus to make sensor. The Examiner asserted that neither the manner of operating a disclosed device nor material/article worked upon further limit an apparatus claim. The Examiner asserted that such limitations do not differentiate apparatus claims from the prior art. The Examiner further asserted that intended use limitations, such as "making a sensor" and "wherein the object to be welded comprises a sensor device" do not have patentable weight in the apparatus claim.

The Applicant respectfully disagrees with this assessment and notes that in light of the arguments presented above against the rejection to claims 1-7, 10, 11 and 14-17, the Examiner's arguments with respect to claims 5-7 and 11 are irrelevant. That is, the Vongfuangfoo reference does not disclose all of the claim limitations of Applicant's claims 1-7, 10, 11 and 14-17, thereby failing to satisfy the aforementioned prima facie obviousness test.

#### **IV. Allowable Subject Matter**

The Examiner objected to claims 8, 9, 12, 13 and 18-20 as being dependent upon a rejected base claim. The Examiner indicated that claims 8, 9, 12, 13 and

18-20 would, however, be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 10 (i.e., a base claim for dependent claim 12) has been amended to incorporate the claim limitations of claim 12. There are no intervening claims between claim 12 and claim 10, because claim 10 depended directly from claim 10. It is believed that claim 10 as now amended is allowable because it incorporate all of the limitations of the base claim 10 and directly dependent claim 12. Because claim 12 has been cancelled and claim 10 allowable it is believed that any claims dependent upon claim 10 should also be allowed.

Claim 14 (i.e., a base claim for dependent claims 18-20) has been amended to incorporate the claim limitations of claims 18-20, which are cancelled. The Applicant thus submits that claim 14 as now amended comprises a rewritten Independent form of claims 18-20 Including all of the limitations of the base claim an any intervening claims. Because claim 14 is now allowable, the Applicant submits that any claims dependent upon claim 14 should also be allowable.

## **V. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. The Applicant has also amended the claims and specification and submits that such amendments are proper and do not constitute new matter.

Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to

conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: February 20, 2006

A handwritten signature in black ink, reading "Kermit Lopez", is written over a horizontal line.

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